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37 C.F.R. 1.8

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November 1, 2004
Date

David L. Parker

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lopez-Berestein et al.

Serial No.: 09/982,113

Filed: October 17, 2001

For: A METHOD TO INCORPORATE N-(4-HYDROXYPHENYL) RETINAMIDE IN LIPOSOMES

Group Art Unit: 1615

Examiner: Kishore, Gollamudi S.

Atty. Dkt. No.: UTSC:660US

PETITION TO GROUP DIRECTOR PURSUANT TO 37 C.F.R §§1.127 AND 1.181

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

Appellants hereby petition the Group Director under 37 C.F.R §§1.127 and 1.181 to request that the Examiner be instructed to enter the amendments sought after Final Action. While the present petition is filed more than two months after denial of entry, the Group Director is requested nonetheless take action in light of the facts, set forth below, which will demonstrate that Appellants sought several courses of action, to no avail, in an attempt to avoid the necessity of the present petition.

It appears that no fee is due in connection with the filing of this Petition. However, should any fees be due, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No. 50-1212/UTSC:660US.

Statement of Facts

A final rejection was entered in this case and mailed February 20, 2004. Upon review of that Action, the present Appellants concluded that the Examiner had failed to make out a *prima facie* rejection of at least dependent claims 138-141. Therefore, in an amendment and response to final filed April 12, 2004, Appellants sought to introduce the limitations of dependent claim 138 into main claim 54. Concurrently, Appellants sought other amendments consistent with this action (*i.e.*, cancel claims 55, 133 and 138, and an amendment to claims 134 and 139 to change their dependencies).

As can be seen from the record, the amendment sought to claim 54 precisely mirrored the language of dependent claim 138. Nonetheless, this amendment was refused entry in an Advisory Action dated June 4, 2004 for reasons not entirely apparent on the record. Examiner Kishore was contacted and requested to explain and reconsider. He indicated at that time that he did not enter the amendment because it broadened the claim.

Therefore, in order to avoid the time necessary for a decision on petition, Appellants chose instead to simply appeal the rejections of claims 138-141. While only the rejection of these claims were appealed, Appellants wanted to maintain the possibility of adding back in the dependent claims 55-60 and 131-137 following appeal as proposed in the amendment sought after final. Thus, Appellants did not cancel the other pending claims, thinking that it would be appropriate to merely appeal claims 138-141.

On October 1, 2004, the Examiner sent a notice to Appellants indicating that cancellation of all non-appealed claims was required. The Appellants then contacted Examiner Kishore who reaffirmed that he would not enter the amendment to claim 54 as it presented new issues. We attempted to contact SPE Thurman Page, but two phone calls were never returned. Finally, on

October 27, 2004, a telephone call to special examiner Deborah Reynolds was made in an attempt to clear up the matter of whether the amendment sought to claim 54 was appropriate. Examiner Reynolds left a message at the undersigned counsel's office on October 29, 2004, indicating that she agreed with the position taken by the Examiners Kishore and Page, that the amendment broadened the claim scope and thus required further consideration and would not be entered. Appellants' counsel was also instructed that the revised appeal brief must be filed no later November 1, 2004, or the appeal would be dismissed.

Argument

Appellants submit that the amendment to claim 54 did not present new considerations and should have been entered. The amendment sought to claim 54 after final is as follows:

54. (Currently Amended) A method of treating a subject having cancer, comprising administering to said individual a therapeutically effective amount of a composition comprising N-(4-hydroxyphenyl) retamide, or a derivative thereof, encapsulated in a lipid material, wherein said lipid material comprises dimyristoyl phosphatidylcholine (DMPC) and ~~one or more of soybean oil (SO) and water.~~

At the same time, Appellants sought to cancel claim 138. Claim 138 read as follows:

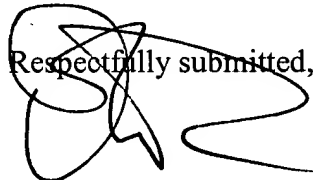
138. The method of claim 54, wherein the lipid material comprises DMPC and water.

It is submitted that the amendment sought to claim 54 is precisely that subject matter contained in dependent claim 138, and should have been entered for the purpose of narrowing

the considerations for appeal. Stated another way, when claim 138 is placed into independent form, it looks exactly like the amended claim 54 that was sought:

138. (Currently amended) A method of treating a subject having cancer, comprising administering to said individual a therapeutically effective amount of a composition comprising N-(4-hydroxyphenyl) retamide, or a derivative thereof, encapsulated in a lipid material, ~~The method of claim 54,~~ wherein the lipid material comprises dimyristoyl phosphatidylcholine (DMPC) and water.

Accordingly, the Group Director is requested to instruct the Examiner to enter the amendment after final and proceed with the current appeal based on the claims following such amendment.

Respectfully submitted,


David L. Parker
Reg. No. 32,165
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512) 536-5201
(512) 536-4598 (facsimile)

Date: November 1, 2004